



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------------|------------------|
| 10/536,662 | 05/27/2005 | Wataru Tomiya | 38318 | 9842 |
| 52054 | 7590 | 03/07/2006 | | |
| PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108 | | | EXAMINER MARSH, OLIVIA MARIE | |
| | | | ART UNIT 2686 | PAPER NUMBER |

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/536,662 | TOMIYA ET AL. | |
| | Examiner | Art Unit | |
| | Olivia Marsh | 2686 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>PTO-1449 5/27/2005</u> |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In light of the specification, applicant's invention is not the portable terminal apparatus, as claimed in line 1, claim 1, but is the program defining claimed "accessing process sequence setting unit," "accessing process sequence storage unit," and "accessing process executing unit." The Examiner has made this determination in light of applicant's specification, page 13, lines 24-26 and in view of the following:

(1) Claims directed to nothing more than abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature are not eligible and therefore are excluded from patent protection. *Diehr*, 450 U.S. at 185, 209 USPQ at 7; accord, e.g., *Chakrabarty*, 447 U.S. at 309, 206 USPQ at 197; *Parker v. Flook*, 437 U.S. 584, 589, 198 USPQ 193, 197 (1978); *Benson*, 409 U.S. at 67-68, 175 USPQ at 675; *Funk*, 333 U.S. at 130, 76 USPQ at 281. "A principle, in the abstract, is a fundamental truth; an

Art Unit: 2686

original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right." *Le Roy*, 55 U.S. (14 How.) at 175.

As stated by applicant on page 13, lines 24-26, the claimed subject matter of claim 1, lines 7-16 are programs, which constitute abstract ideas, which are excluded from patent protection.

(2) However, for claims including such excluded subject matter to be eligible, the claim must be for a practical application of the abstract idea, law of nature, or natural phenomenon. *Diehr*, 450 U.S. at 187, 209 USPQ at 8 ("application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection."); *Benson*, 409 U.S. at 71, 175 USPQ at 676 (rejecting formula claim because it "has no substantial practical application").

The claimed programs (accessing process sequence setting unit, accessing process sequence storage unit, and accessing process executing unit) fail to produce a useful, concrete, and tangible result in their currently claimed form.

(3) Even when a claim applies a mathematical formula, for example, as part of a seemingly patentable process, the examiner must ensure that it does not in reality "seek patent protection for that formula in the abstract." *Diehr*, 450 U.S. at 191, 209 USPQ at 10. "Phenomena of nature, though just discovered, mental processes, abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work." *Benson*, 409 U.S. at 67, 175 USPQ at 675. One may not patent a process that comprises every "substantial practical application" of an abstract idea, because such a patent "in practical effect would be a patent on the [abstract idea] itself." *Benson*, 409 U.S. at 71-72, 175 USPQ at 676; cf. *Diehr*, 450 U.S. at 187, 209 USPQ at 8.

Art Unit: 2686

Claim 1 is directed towards an apparatus; however, applicant's invention is not an apparatus but the programs (accessing process sequence setting unit, accessing process sequence storage unit, and accessing process executing unit) residing on the portable terminal. Therefore, the claim 1 is directed towards non-statutory matter.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Higuchi et al (U.S. 2003/0050050 A1).**

As to claim 1, Higuchi discloses:

A portable terminal apparatus (mobile terminal 12), comprising:
a network access unit (transceiver circuit 32) that accesses a site on a network so as to acquire data (paragraph 54);
a data storage unit (memory card 58) that stores the acquired data thereinto (paragraph 109);
an accessing process sequence setting unit capable of arbitrarily setting an access setting condition relating to the access operation to the site on the network in response to an instruction of a user, the access setting

Art Unit: 2686

condition containing an access destination, a time instant, and a processing sequence (paragraphs 62-63);

an accessing process sequence storage unit that stores a series of processing sequences based upon the set access setting condition (paragraph 65); and

an accessing process executing unit that executes a predetermined processing sequence to perform an accessing process operation to the set site in accordance with the access setting condition when the present time is reached to a preset time instant (paragraph 72).

As to **claim 2**, Higuchi discloses everything as applied in claim 1 and Higuchi also discloses:

the accessing process sequence setting unit sets a processing sequence in at least one of an access starting process sequence for starting an access operation to the set site at the preset time instant, a data acquiring process sequence for acquiring data from the accessed site, and a data storing process sequence for storing the acquired data into the data storage unit (paragraph 73).

As to **claim 3**, Higuchi discloses everything as applied in claims 1-2 and Higuchi also discloses:

the accessing process sequence setting unit sets a process sequence during out of service area in the case that the own apparatus is located outside the service area where communications can be performed when an access operation to the set site is commenced in the access starting process sequence (paragraph 75).

Art Unit: 2686

As to **claim 4**, Higuchi discloses everything as applied in claims 1-2 and Higuchi also discloses:

the accessing process sequence setting unit sets a process sequence during site access failure in the case that the accessing operation is failed when the set site is access in the data acquiring process sequence (paragraph 110).

As to **claim 5**, Higuchi discloses everything as applied in claims 1-2 and Higuchi also discloses:

the accessing process sequence setting unit sets a process sequence during site access failure in the case that the accessing operation is failed when the set site is accessed in the data acquiring process sequence (paragraph 75).

As to **claim 6**, Higuchi discloses everything as applied in claims 1-2 and Higuchi also discloses:

the accessing process sequence setting unit sets a process sequence during interruption in the case that the own apparatus accepts an interrupt request when data is acquired from the set site in the data acquiring process sequence (paragraph 77).

As to **claim 7**, Higuchi discloses everything as applied in claims 1-2 and Higuchi also discloses:

the accessing process sequence setting unit sets a process sequence during data acquisition failure in the case that the own apparatus fails to acquire the data when data is acquired from the set site in the data acquiring process sequence (paragraph 87).

Art Unit: 2686

As to **claim 8**, Higuchi discloses everything as applied in claims 1-2 and Higuchi also discloses:

the accessing process sequence setting unit sets a process sequence during storage memory shortage in the case that a storage capacity of the data storage unit becomes short when the acquired data is stored in the data storing process sequence (paragraph 76).

As to **claim 9**, Higuchi discloses everything as applied in claim 1 and Higuchi also discloses:

a retrieving unit (46) that retrieves the acquired data stored in the data storage unit (paragraph 112).

As to **claim 10**, Higuchi discloses everything as applied in claim 1 and Higuchi also discloses:

the accessing process sequence setting unit is capable of setting a transfer destination to which the acquired data is transferred (paragraph 120); and

the portable terminal apparatus further comprises a data transferring unit (46) that transfers the acquired data to the set transfer destination (paragraph 120).

Art Unit: 2686

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olivia Marsh whose telephone number is 571-272-7912. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571-272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marsha D Banks-Harold
MARSHA D. BANKS-HAROLD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2000